

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 4, 2003. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 2-3 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In that it is believed that every rejection has been overcome, it is submitted that each of the claims that remains in the case is presently in condition for allowance.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 1 and 4-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Choksi, et al. ("Choksi," U.S. Patent No. 6,477,243) in view of Luzeski, et al. ("Luzeski," U.S. Pat. No. 6,430,177).

The rejection alleges that Choksi discloses Applicant's invention substantially as claimed with the exception of "using a predetermined a data set size threshold to decide whether to send the message in a particular rout and format." The rejection concludes, however, that in view of the Luzeski disclosure, it would have been obvious to a person having ordinary skill in the art to provide that aspect to the Choksi system. Applicant respectfully traverses this rejection.

B. The Choksi Reference

Choksi discloses a method and apparatus for confirming receipt of a facsimile message. Choksi discusses operation of the system in columns 4 and 5. As described by Choksi in column 5:

A facsimile message 12 is transmitted from a transmitting facsimile machine 14 across the public switched telephone network (PSTN) 16 to a computer 18 where the facsimile message 12 is received. . . . Upon receipt of a facsimile message 12, computer 18 forwards a notification message which indicates such reception to the intended recipient 23. The notification message may be transmitted to a communication device or address such as an e-mail address

Choksi, column 5, lines 2-16. Therefore, it is clear that Choksi only concerns receiving a facsimile and sending a confirmation (e.g., an email message) back to the sender of the facsimile that the facsimile was in fact received.

C. Discussion of the Rejection

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied

reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

As described above, the Choksi reference, which is cited as the base reference in the rejection, only concerns receiving a facsimile and sending a confirmation (e.g., an email message) back to the sender of the facsimile that the facsimile was in fact received. In view of that fact, it is clear that Choksi cannot form the basis of a proper rejection of Applicant's claims. Applicant briefly discusses the deficiencies of the Choksi reference as to each of Applicant's independent claims in the following.

Regarding independent claim 1, Choksi does not teach or suggest any of "predetermining a data set size threshold for electronic mail attachments", "determining a data set size of an electronic mail attachment prior to transmission of an electronic mail message to which the attachment is appended", "if said data set size is less than said threshold, transmitting the attachment via electronic mail to an intended recipient", or "if said data set size is greater than said threshold, transmitting the data set to a separate data storage site instead of the intended recipient" as is required by claim 1. In that Luzeski does not provide a teaching sufficient to overcome those deficiencies of the Choksi reference, the proffered combination fails to render Applicant's claim 1 obvious.

With regard to independent claim 8, Choksi does not teach or suggest any of a "digital sender configured to transmit data sets as electronic mail attachments", "means for determining size of a data set to be routed to a predetermined electronic mail destination", "means for comparing a determined data set size to a threshold", "means for rerouting the data set from electronic mail to a data storage site when said determined data set size is greater than said threshold such that the data set is not transmitted as an electronic mail attachment", or "means for substituting an electronic mail message for an original electronic mail message, the substituted electronic mail

message including a link to the data site and for sending the substituted electronic mail message to the predetermined electronic mail destination when said determined data set size is greater than said threshold” as is required by claim 8. In that Luzeski does not provide a teaching sufficient to overcome those deficiencies of the Choksi reference, the proffered combination fails to render Applicant’s claim 8 obvious.

With respect to independent claim 14, Choksi does not teach or suggest a “document digitizing subsystem for converting a document into a digital data set that can be transmitted as an electronic mail attachment” or a “routing subsystem for determining if a data set is to be transmitted via electronic mail or via a data storage unit relative to a determined size of the data set” as is required by claim 14. In that Luzeski does not provide a teaching sufficient to overcome those deficiencies of the Choksi reference, the proffered combination fails to render Applicant’s claim 14 obvious.

In regard to independent claim 18, Choksi does not teach or suggest “computer readable coded instructions for predetermining a data set size threshold”, “computer readable coded instructions for determining a data set size”, “computer readable coded instructions for transmitting the data set via electronic mail to an intended recipient if the data set size is less than the threshold”, or “computer readable coded instructions for transmitting the data set to a data storage site instead of the intended recipient if the data set size is greater than the threshold” as is required by claim 18. In that Luzeski does not provide a teaching sufficient to overcome those deficiencies of the Choksi reference, the proffered combination fails to render Applicant’s claim 18 obvious.

As a further point, Applicant respectfully submits that the combination of Choksi and Luzeski, as to all of the rejected claims, is flawed because even if it were assumed that the two references were properly combinable, the resulting combination simply would not satisfy Applicant’s claims. Specifically, the proffered combination

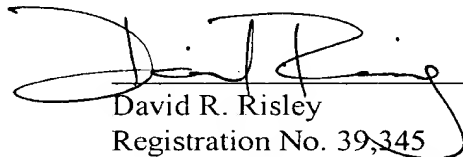
does not satisfy many or most of the explicit claim limitations found in Applicant's claims both in their original form and as amended. Applicant directs the Examiner's attention to the discussion of the independent claims above, which highlights several such unaccounted-for limitations.

In summary, it is Applicant's position that the outstanding rejection is flawed and fails to render Applicant's claims obvious. Therefore, it is respectfully submitted that each of Applicant's claims is patentable and that the rejection should be withdrawn.

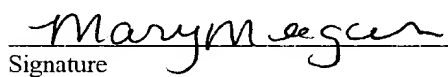
CONCLUSION

Applicant respectfully submits that pending claims 1-20 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

12-1-03

Signature